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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 11

Application Number: 09/307,261
Filing Date: May 06, 1999
Appellant(s): HOOVER ET AL.

MAILED

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Robert J. Crawford
For Appellant

GROUP 3600

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 14, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The Examiner maintains that he did present prior art correspondence and evidence of motivation to combine the asserted references. The

issues before the board are whether, with respect to the various claims, the prior art of record and evidence of motivation to combine are sufficient.

(7) Grouping of Claims

Appellant's brief includes a statement that the claims of Group I, claims 1-2 and 4-24; the claims of Group II, claims 36-50; and the claims of Group III, claims 51-58, do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,983,201	FAY	09-1999
6,170,017	DIAS et al.	01-2001
4,261,012	MALOOMIAN	04-1981
5,970,471	HILL	10-1999
5,774,670	MONTULLI	06-1998
5,163,007	SLILATY	11-1992
5,881,234	SCHWOB	03-1999
5,802,530	VAN HOFF	09-1998

The Microsoft Press Computer Dictionary, third edition, Microsoft Press, 1997, pages 92,197, and 430.

Merriam-Webster's Collegiate Dictionary, tenth edition, Merriam-Webster, 1997, page 644.

Brown, J., "Macy's Eases Swimsuit Fear with Database,"
<http://www.wired.com/news/news/story/3226.html> (April 17, 1997).

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Response to Challenges of Official Notice

Applicant has challenged Examiner's various takings of official notice. In sustaining the rejections, Examiner therefore has the responsibility to justify his takings of official notice. Such justifications follow:

In rejecting claims 1 and 36, Examiner took official notice that the use of server computers is well known. Similarly, in rejecting claim 13, Examiner took official notice that the use of server computers and client computers is well known; also similarly, in rejecting claims 43, 51, 73, 77, and 80, Examiner took official notice that client-server architecture is well known. All of this is supported by the Microsoft Press Computer Dictionary, third edition [*published 1997*], definitions of client (sense 3), client-server architecture, server, server-based application, server cluster, server error, server push-

pull, and server side includes (pages 92 and 430). The relevant pages of the Microsoft Press Computer Dictionary were made of record in the previous Office action.

In rejecting claim 9, Examiner took official notice that it is well known to present images, and product images in particular, against a selected background. This is supported by Hill, U.S. Patent 5,970,471, Abstract and column 2, lines 48-65; and by Maloomian, U.S. Patent 4,261,012, column 4, lines 30-36. Both of these patents were made of record in the previous Office action, and the relevant parts referred to in the rejection of claim 9.

In rejecting claim 20, Examiner took official notice that it is well known to display images, and in particular, the images of products for sale, on Web pages. This is supported by Montulli, U.S. Patent 5,774,670, column 12, lines 11-49.

In rejecting claim 24, Examiner took official notice that it is well known to manually enter data of an intended recipient's body parameters. This is supported by Slilaty, U.S. Patent 5,163,007, (Abstract; column 3, lines 12-16; column 4, lines 27-42).

In rejecting claim 25, Examiner took official notice that it is well known to make multiple images of a person (in different poses, from different angles, etc.). This is supported by Rose, U.S. Patent 5,930,769, column 3, lines 56-62.

In rejecting claims 26, 32, and 61, Examiner took official notice that it is well known to display the prices of products displayed for sale (with a minor difference in wording regarding claim 32). This is supported by Watts (U.S. Patent 3,590,434; column 1, lines 7-12) and, with particular reference to online shopping, by Ikeda (U.S. Patent 5,937,391, column 4, lines 3-14).

In rejecting claim 30, Examiner took official notice that it is well known to delete what is unwanted and save what is wanted. This is supported by Pashley et al. (U.S. Patent 5,978,833) column 3, lines 17-26.

In rejecting claim 31, Examiner took official notice that it is well known to save what is wanted in an appropriate file. This is supported by Levine et al. (U.S. Patent 5,745,681), as mentioned in the rejection; specifically, the Abstract, and column 1, line 50, through column 2, line 47.

In rejecting claims 38 and 54, Examiner took official notice that firewalls are well known. This is supported by the Microsoft Press Computer Dictionary, third edition, definition of firewall, page 197. The relevant pages of the Microsoft Press Computer Dictionary were made of record in the previous Office action.

In rejecting claim 39, Examiner took official notice that it is well known for Internet users to have Internet Service Providers. This is supported by Schwob (U.S. Patent 5,881,234), column 1, lines 16-45, and in particular lines 16-20.

In rejecting claim 42, Examiner took official notice that that it is well known to present images, and product images in particular, against a selected background. This is supported by Hill, U.S. Patent 5,970,471, Abstract and column 2, lines 48-65. Hill's patent was of record in the previous Office action, and the relevant parts referred to in the rejection of claim 42.

In rejecting claim 57, Examiner took official notice that it is well known for kiosks to contain items for sale. This is supported by Merriam-Webster's Collegiate Dictionary, tenth edition, definition of kiosk (sense 2), page 644.

In rejecting claim 58, Examiner took official notice that communication over the Internet frequently involves the use of a Web browser computer program. This is supported by Van Hoff, U.S. Patent 5,802,530, column 1, lines 45-56.

[Support for takings of official notice made only with regard to claims which have been cancelled and are not at issue in the appeal have been deleted.]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-5, 8-12, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay (U.S. Patent 5,983,201) in view of Dias et al. (U.S. Patent 6,170,017). As per claim 1, Fay discloses a method for previewing an accessory to be

worn by a person, the method comprising: providing a first image to an input device at a first location, the first image including at least a portion of a person (Abstract); transmitting data of the first image to a computer at a second location (Abstract); selecting a second image from an electronic database of images on or accessible to the computer at the second location, the second image comprising an image of an accessory to be worn on the portion of the person in the first image (Abstract); generating data of a composite image from the data of the first image and data of the second image with computer at the second location, the composite image including the accessory worn on the portion of the person (Abstract); and displaying the composite image on an output device at the first location (Abstract; column 6, lines 4-33; the output device is inherent from what the customer is described as doing). Fay does not expressly disclose that the computer at the second location is a server computer, and Fay does not disclose that the server computer is linked to different accessory-provider computer sites respectively having different accessories for viewing, but Dias teaches a server computer linked to different merchandise-provider computer sites respectively having different items of merchandise available for information and for purchase (column 1, line 56, through column 2, line 32). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the computer at the second location be a server computer linked to different accessory-provider computer sites respectively having different accessories for viewing, for the advantages, as stated by Dias, of coordinating the authentication of a client

among a set of stores, integrating information from multiple stores, and coordinating requests for group transactions from multiple stores.

As per claim 2, Fay discloses that the transmitting of data can be done over the Internet (column 8, line 63, through column 9, line 4).

As per claim 4, Fay discloses that the first image comprises the face of the person (Abstract), and that selecting the second image is performed in accordance with the person's interpupil distance (column 5, lines 17-24).

As per claim 5, Fay discloses purchasing the accessory after displaying the composite image (Abstract, final sentence; column 6, lines 34-53).

As per claim 8, Fay discloses that the accessory can comprise sunglasses (column 2, lines 50-60; column 8, lines 38-39).

As per claim 9, Fay does not disclose selecting a third image of a background setting prior to generating data of a composite image, and wherein generating data of a composite image comprises generating data of a composite image from the data of the first image, data of the second image, and data of the third image. However, official notice is taken that it is well known to present images, and product images in particular, against a selected background (see, for example, Hill, U.S. Patent 5,970,471, Abstract and column 2, lines 48-65; for another example, Maloomian, U.S. Patent 4,261,012, column 4, lines 30-36). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select a third image of a background setting, and have generating data of a composite image comprise generating data of a composite image from data of the third image as well as first and

second, for the obvious advantage of presenting the accessory in an attractive manner, which could be expected to increase sales and profits.

As per claim 10, Fay discloses that the input device can comprise a digital camera (column 4, lines 10-14; column 5, lines 8-24; column 6, lines 54-60; column 7, lines 23-29 and 46-50; column 7, line 66, through column 8, line 19).

As per claim 11, Fay discloses that the accessory can comprise cosmetics or jewelry (column 9, lines 4-8).

As per claim 12, Fay discloses that the first location can be a kiosk (column 5, lines 25-31).

As per claim 67, Fay discloses that the accessory can be a pair of prescription eyeglasses (Abstract, first sentence).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fay and Dias as applied to claim 1 above, and further in view of Maloomian (U.S. Patent 4,261,012). Fay does not disclose manipulating data of the first image to modify a size of the first image to correspond to a template having a predetermined size, but Maloomian teaches this (column 3, lines 49-59). Maloomian further teaches that selecting a second image comprises using the template to select the second image (column 3, line 30, through column 4, line 7). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to manipulate data of the first image to modify a size of the first image to correspond to a template having a predetermined size, wherein selecting a second image comprises using the template to select the second image, for the advantage, as taught by

Maloomian, of presenting an image enabling a user to judge what he would look like wearing a particular article.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fay and Dias as applied to claim 1 above, and further in view of Maloomian (U.S. Patent 4,261,012). Fay does not disclose manipulating data of the first image to modify a size of the first image to correspond to a template having a predetermined size, but Maloomian teaches this (column 3, lines 49-59). Maloomian also teaches that generating data of a composite image comprises using data of the template to generate data of the composite image (column 2, lines 42-65; column 3, line 30, through column 4, line 7). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to manipulate data of the first image to modify a size of the first image to correspond to a template having a predetermined size, wherein generating data of the composite image comprised using data of the template to generate data of the composite image, for the advantage, as stated by Maloomian, of enabling a user to judge what he would look like wearing a particular article.

Claims 13-16, 19-24, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay in view of Dias. As per claim 13, Fay discloses a method for previewing an accessory, the method comprising: providing data of a first image of at least a portion of an intended recipient of the accessory to a first computer (Abstract); selecting a second image from an electronic database of images, the second image of

an accessory to be worn on the portion of the intended recipient in the first image (Abstract); generating data of a composite image from the data of the first image and data of the second image with the first computer (Abstract); transmitting the data of the composite image from the first computer to a second computer (Abstract); and displaying the composite image on an output device in communication with the second computer (Abstract; column 6, lines 4-33; the output device is inherent from what the customer is described as doing). Fay does not expressly disclose that the first computer is a server computer, and Fay does not disclose that the server computer is linked to different accessory-provider computer sites respectively having different accessories for viewing, but Dias teaches a server computer linked to different merchandise-provider computer sites respectively having different items of merchandise available for information and for purchase (column 1, line 56, through column 2, line 32). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the computer at the second location be a server computer linked to different accessory-provider computer sites respectively having different accessories for viewing, for the advantages, as stated by Dias, of coordinating the authentication of a client among a set of stores, integrating information from multiple stores, and coordinating requests for group transactions from multiple stores.

Fay does not expressly disclose that the second computer is a client computer, but official notice is taken that client-server architecture computers is well known; the computers of Fay's invention might even be considered to be a server computer and a

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client computer on the basis of what they do, even without the words "server" and client being used. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the second computer be a client computer, for the obvious advantage of having the transmittal and implementation of data and instructions carried out according to standard, widely used techniques.

As per claim 14, Fay discloses that the accessory can comprise sunglasses (column 2, lines 50-60; column 8, lines 38-39).

As per claim 15, Fay discloses that the output device can be located at the customer's home (column 2, lines 50-56).

As per claim 16, Fay discloses that the second (client) computer can be located at a kiosk (column 5, lines 25-31).

As per claim 19, Fay discloses that transmitting the data can comprise transmitting the data via the Internet (column 8, line 63, through column 9, line 4).

As per claim 20, Fay does not expressly disclose that displaying the composite image on the output device comprises displaying the composite image on a Web page, but Fay does disclose the use of the Internet (column 8, line 63, through column 9, line 4), and official notice is taken that it is well known to display images, and in particular, to display images of products for sale, on Web pages. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display the composite image on a Web page, for the obvious advantage of

making the image conveniently available to the increasing multitude of customers with Web access.

As per claim 21, Fay discloses that providing data of the first image comprises retrieving data of the first image from an information medium on or accessible to the first computer (column 5, lines 55-60).

As per claim 22, Fay discloses that the intended recipient of the accessory is a customer (Abstract).

As per claim 23, Fay discloses that the accessory can comprise jewelry or cosmetics (column 9, lines 4-8).

As per claim 24, Fay discloses selecting a plurality of accessory images from an electronic database of image in accordance with the data of an intended recipient's body parameters (Abstract; column 5, lines 55-65), and displaying the plurality of accessory images (column 6, lines 4-12). Fay does not disclose manually entering data of an intended recipient's body parameters, but official notice is taken that it is well known to manually enter data of an intended recipient's body parameters. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce to have data of an intended recipient's body parameters manually entered, for the obvious advantage of making it possible to select or custom-make an accessory fitting the intended recipient without the difficulty and expense of using digital cameras and other scanning equipment, which may not be conveniently available.

As per claim 68, Fay discloses that the accessory can be a pair of prescription eyeglasses (Abstract, first sentence).

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay and Dias as applied to claim 13 above, and further in view of Maloomian (U.S. Patent 4,261,012). As per claim 17, Fay does not expressly disclose manipulating data of the first image so that the first image is modified and corresponds to a template, but Maloomian teaches this (column 3, lines 49-59). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to manipulate data of the first image so that the first image was modified and corresponded to a template, for the advantage, as stated by Maloomian, of presenting a true proportional figure composite to the viewer-consumer.

As per claim 18, Maloomian further teaches selecting plural accessory (or at least clothing) images from the database with the template and displaying the plural images (column 3, line 30, through column 4, line 7). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select plural accessory images from the database with the template and display the plural accessory images, for the obvious advantage of enabling the user to select among plural accessories.

Claims 36-42 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay in view of Dias. As per claim 36, Fay discloses a system for previewing an accessory, comprising: an input device for receiving a first image, wherein the first image includes an image of at least a portion of a person (abstract; column 5, lines 8-31); a first computer operatively coupled to the input device (column 5, lines 8-31); a

second computer including a first computer program for selecting data of a second image from an electronic database of images, the second image comprising an image of an accessory to be worn on the portion of the person in the first image (column 5, line 55, through column 6, line 12), and a second computer program for generating data of a composite image from data of the first image and data of the second image, wherein the second computer is operatively connected to the first computer (column 5, line 55, through column 6, line 12); and an output device for displaying the composite image, wherein the output device is operatively coupled to the first computer (column 6, lines 4-12), wherein the input device, first computer, and the output device are at a first location and wherein the second computer is located at a second location (Abstract; column 5, lines 55-60). Fay does not expressly disclose that the second computer is a server computer, and Fay does not disclose that the server computer is linked to different accessory-provider computer sites respectively having different accessories for viewing, but Dias teaches a server computer linked to different merchandise-provider computer sites respectively having different items of merchandise available for information and for purchase (column 1, line 56, through column 2, line 32). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the second computer be a server computer linked to different accessory-provider computer sites respectively having different accessories for viewing, for the advantages, as stated by Dias, of coordinating the authentication of a client among a set of stores, integrating information from multiple stores, and coordinating requests for group transactions from multiple stores.

Fay does not expressly disclose that the first computer is a client computer, but official notice is taken that client-server architecture is well known; the first computer of Fay's invention might be considered to be a client computers, respectively, on the basis of what it does, even without the words "client" and "server" being used. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the first computer be a client computer, for the obvious advantage of having the transmittal and implementation of data and instructions carried out according to standard, widely used techniques.

As per claim 37, Fay discloses that access may take place over the Internet (column 6, lines 61-63; column 8, line 63, through column 9, line 4).

As per claim 38, Fay does not expressly disclose a firewall between the second computer and the first computer, but official notice is taken that firewalls are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a firewall between the computers, for the obvious advantage of protecting against theft or unauthorized disclosure of private data and other damage that may be done by crackers.

As per claim 39, Fay does not expressly disclose an Internet service provider intermediate between the first and second computers, but does disclose use of the Internet (column 8, line 63, through column 9, line 4), and official notice is taken that it is well known for Internet users to have Internet service providers. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have an Internet service provider intermediate between the first

and second computers, for the obvious advantage of enabling Internet users to have convenient access to the second computer.

As per claim 40, Fay discloses a computer program for processing purchases (column 6, lines 34-39), the program(s), as such, being implicit from the functions which the computer is described as carrying out.

As per claim 41, Fay discloses that the accessory can comprise sunglasses (column 2, lines 50-60; column 8, lines 38-39).

As per claim 42, Fay does not disclose that the second computer comprises a third computer program for selecting a background database from an electronic database of background images, but official notice is taken that it is well known to present images, and product images in particular, against a selected background (see, for example, Hill, U.S. Patent 5,970,471, Abstract and column 2, lines 48-65). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention include a computer program for selecting a background image from an electronic database of background images, for the obvious advantage of presenting the accessory in an attractive manner, which could be expected to increase sales and profits.

As per claim 70, Fay discloses that the accessory can be a pair of prescription eyeglasses (Abstract, first sentence).

Claims 43-50 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay in view of Dias. As per claim 43, Fay discloses a system for previewing an

accessory, comprising: an information storage medium comprising a first electronic database of images of people (column 5, lines 8-24 and 55-60); a first computer including (i) a first computer program for selecting a first image from the first electronic database, the first image comprising an image of an intended recipient of an accessory (column 5, lines 5-60), (ii) a second computer program for selecting a second image from a second electronic database, the second image comprising an image of an accessory to be worn on the intended recipient in the first image (column 5, line 60, through column 6, line 3), and (iii) a third computer program for generating data of a composite image illustrating the accessory being worn on the intended recipient from the data of the first image and data of the second image (Abstract; column 5, line 60, through column 6, line 3), wherein the first computer is operatively connected to a second computer (column 5, lines 55-60; column 6, lines 61-63); a second computer for receiving the data of the composite image, wherein the second computer is operatively connected to the first computer (column 5, lines 55-60; column 6, lines 4-17; and column 6, lines 61-63); and an output device for displaying the composite image, wherein the output device is operatively coupled to the second computer (implicit in column 6, lines 4-17). Insofar as Fay is not explicit about the computer programs, the existence of appropriate programs is held to be inherent from the descriptions of what the computer system does.

Fay does not expressly disclose that the first computer is a server computer, and Fay does not disclose that the server computer is linked to different accessory-provider computer sites respectively having different accessories for viewing, but Dias teaches a

server computer linked to different merchandise-provider computer sites respectively having different items of merchandise available for information and for purchase (column 1, line 56, through column 2, line 32). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the computer at the second location be a server computer linked to different accessory-provider computer sites respectively having different accessories for viewing, for the advantages, as stated by Dias, of coordinating the authentication of a client among a set of stores, integrating information from multiple stores, and coordinating requests for group transactions from multiple stores.

Fay does not expressly disclose that the second computer is a client computer, but official notice is taken that client-server architecture is well known; the second computer of Fay's invention might be considered to be a client computer, on the basis of what it does, even without the words "client" and "server" being used. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the second computer be a client computer, for the obvious advantage of having the transmittal and implementation of data and instructions carried out according to standard, widely used techniques.

As per claim 44, Fay discloses the use of the Internet to operatively couple computers (column 6, lines 61-63; column 8, line 63, through column 9, line 4).

As per claim 45, Fay discloses an input device operatively coupled to the second computer (column 6, lines 4-9).

As per claim 46, Fay discloses that the accessory can comprise sunglasses (column 2, lines 50-60; column 8, lines 38-39).

As per claim 47, Fay discloses a kiosk, where the second computer is at the kiosk (column 5, lines 25-31).

As per claim 48, Fay discloses a computer program for processing a purchasing transaction (column 6, lines 34-39), the program(s), as such, being implicit from the functions which the computer is described as carrying out.

As per claim 49, Fay does not expressly disclose two or more databases, each of the databases containing different accessories, but does disclose that his invention can be used for different kinds of accessories (column 9, lines 4-13). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the storage medium include two or more databases, each of the databases containing different accessories, for the obvious advantage of conveniently displaying and selling different kinds of accessories.

As per claim 50, Fay discloses that the intended recipient is a customer (Abstract).

As per claim 71, Fay discloses that the accessory can be a pair of prescription eyeglasses (Abstract, first sentence).

Claims 51-58 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fay in view of Hill. As per claim 51, Fay discloses a first computer comprising (i) a first computer program for selecting data of a first accessory image from an electronic

database (Abstract; column 5, lines 5-60); (ii) a second computer program for generating data of a first composite image from data of the first accessory image and data of a person's image (column 5, line 60, through column 6, line 3), (iii) a third computer program for selecting data of a second accessory image from the electronic database (column 6, lines 4-12), and (iv) a fourth computer program for generating data of a second composite image from data of the second accessory image and data of the person's image (column 5, line 55, through column 6, line 12); a second computer operatively connected with the first computer (column 5, lines 55-60; column 6, lines 61-63); and a display device for displaying the first and second composite images to a customer for previewing accessories before purchasing (column 5, line 55, through column 6, line 12).

Fay does not expressly disclose that the first computer is a server computer, or that the second computer is a client computer, but official notice is taken that client-server architecture is well known; the first and second computers of Fay's invention might be considered to be server and client computers, respectively, on the basis of what they do, even without the words "client" and "server" being used. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the first and second computers be server and client computers, respectively, for the obvious advantage of having the transmittal and implementation of data and instructions carried out according to standard, widely used techniques.

Fay does not expressly disclose an information storage medium for saving data of the first composite image, the information storage medium being on or accessible to the server first computer, but Fay does disclose that the customer can order a pair of eyeglasses already tried on (column 6, lines 4-9 and 33-53), implying a storage medium storing a record of which eyeglasses (or other accessories) have been tried on.

Fay does not disclose that the first and second composite images are displayed to a customer for *simultaneously* previewing accessories before purchasing, but Hill discloses simultaneously displaying multiple images (Abstract; Figures 9 and 13; column 2, lines 24-37), while Fay discloses a composite image showing an accessory being worn on the person (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to simultaneously display the first and second composite images, for the advantage, as stated by Hill, of readily enabling the customer to compare the images, and choose the accessory (or accessories) which best pleased him.

As per claim 52, Fay discloses that the computers can be operatively coupled via the Internet (column 6, lines 61-63; column 8, line 63, through column 9, line 4).

As per claim 53, Fay discloses processing the sale of an accessory by computer (column 6, lines 33-53), implying a program for doing so.

As per claim 54, Fay does not disclose a firewall between the first and second computers, but official notice is taken that firewalls are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have a firewall between the computers, for the obvious

advantage of protecting against theft or unauthorized disclosure of private data and other damage that may be done by crackers.

As per claim 55, Fay discloses an input device operatively connected to the second computer (column 6, lines 4-9).

As per claim 56, Fay discloses that a second computer can be located at a kiosk (column 5, lines 25-31).

As per claim 57, Fay does not expressly disclose that the kiosk contains accessories for sale, but does disclose that a second computer may be located in any appropriate location, including on the premises of an optician or an optometrist (column 5, lines 29-31), where such accessories as eyeglasses are presumably on sale. Moreover, official notice is taken that it is well known for kiosks to contain items for sale. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the kiosk to contain accessories for sale, for the obvious advantage of enabling customers to readily obtain accessories which they had selected.

As per claim 58, Fay does not expressly disclose that the second computer comprises a Web browser computer program, but does disclose communication over the Internet (column 6, lines 61-63; column 8, line 64, through column 9, line 4). Official notice is taken that communication over the Internet frequently involves the use of a Web browser computer program. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the second computer comprise a Web browser computer program, for the obvious

advantage of enabling the user to conveniently access data made available through the Web, and interact with Web pages to view accessories for sale, make purchases, etc.

As per claim 72, Fay discloses that the accessory can be a pair of prescription eyeglasses (Abstract, first sentence).

[Rejections directed only to claims which have been cancelled, and are not being appealed, have been deleted.]

(11) Response to Argument

Examiner holds that Appellant's inventive concept is essentially that of Fay (U.S. Patent 5,983,201), as reading Fay's Abstract will confirm; Fay, like Appellant, has invented a system for remotely previewing accessories such as eyeglass frames, by acquiring an image of a customer, combining it with an image of the accessory, and displaying the resulting composite image to the customer. Examiner further maintains that those limitations in the appealed claims which Fay does not disclose are obvious in view of the other prior art of record, and that all combinations of references are properly supported, either by the teachings and motivation in the references themselves, or by the knowledge generally available to one of ordinary skill in the art of electronic commerce.

First, while Appellant's three groups of claims need not, in strict logic, stand or fall together, they are largely parallel, so Examiner will concern himself primarily with the first group, and essentially the same arguments will apply to each set of claims,

although where there are different and not strictly parallel limitations in the claims, grounds for considering these limitations unpatentable will be addressed.

As regards the first issue, concerning claims 1-2 and 4-24, Appellants write that Examiner acknowledges that the '201 reference (Fay) fails even to disclose a server computer. What Examiner actually wrote is, "Fay does not *expressly* disclose that the computer at the second location is a server computer" (emphasis added). In his response to arguments (pages 39 and 40 of the final rejection, paper #7 in the file), Examiner pointed out that Fay's two computers might be considered a client and server, based on what they did (note definitions in the Microsoft Press Computer Dictionary); moreover, the amendments which Appellant made after the first action rejection led Examiner to rely on Dias as a secondary reference, dropping the use of official notice, and Dias expressly teaches a server computer linked to different merchandise-provider computer sites (column 1, line 56, through column 2, line 32).

Appellant does not seem to have been willing to rely on the explicit recitation of a server to make his claims patentable over Fay, since he amended claim 1 to recite the server computer being linked to different accessory-provider computer sites having different accessories for viewing, which is slightly less trivial, but is still held not to make the claim patentable. This amounts to reciting a cyber-mall, which is well known, as Dias (the '017 reference) teaches (column 1, line 56, through column 2, line 32). Dias not only teaches a server computer linked to a plurality of store computers which provide products for sale, but also states motivation for using such apparatus in electronic commerce: coordinating the authentication of a client among a set of stores,

integrating information from multiple stores, and coordinating requests from multiple stores.

With regard to composite images, Appellant writes that Examiner did not assert that any such prior-art server computer [which should read: any prior-art computer expressly identified as a server computer] generates data of a composite image having a first image wearing a second image. This would be a cogent argument if Examiner had rejected claim 1 as anticipated by Dias, but he did not. Rather, Dias was relied on to teach a secondary feature not taught by Fay, which does disclose exactly such a composite image. Thus, Examiner's alleged "failure to present prior art correspondence or even the assertion thereof" simply did not occur, and to call the rejection invalid based upon Dias's failure to teach generation of a composite image is attacking the references in a vacuum, without considering the combination of references.

Appellant next argues a failure to present evidence of motivation, despite Dias's clear teaching of reasons to have a server computer linked to a plurality of store computers, asserting that no evidence was cited in support of the assertion that the prior art would lead a skilled artisan to so modify the '201 reference. Since Examiner did cite the relevant section of Dias (column 1, line 56, through column 2, line 32), which includes Dias's statement of the advantages of linking a server computer to a plurality of store computers, he is tempted to dismiss Appellant's assertion as simply erroneous, but Appellant proceeds to write, "Moreover, none of these unsupported suggestions are directed to a server computer generating data of a composite image showing a first image wearing a second image. Without such evidence, the §103(a) reference is

unmotivated.” The first sentence is almost true, except for the term “unsupported suggestions,” which should be “secondary references”; the second sentence is a most unreasonable interpretation of §103(a). Motivation is only required to combine the additional features not recited in the primary reference; no motivation is required for the claim limitations expressly disclosed by the primary reference (in this case Fay, which discloses generating data of a composite image showing a first image wearing a second image). Dias provides motivation for linking an electronic commerce server to different merchandise provider sites, motivation which is not rendered inapplicable by Dias’s failure to write, “This feature is particularly applicable to electronic commerce computers for remotely displaying composite images of customers wearing the merchandise.”

Appellant quotes from *Ruiz v. A.B. Chance Co.*, 234 F.3 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000), “Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the **prior art references** themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or **disclosures** in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, ‘leading inventors to look to **references** relating to possible solutions to that problem.’” Examiner is entirely willing to have the validity of his rejections judged by the standard set forth in *Ruiz*, and calls attention to the statements of motivation set forth in Dias, one of the **prior art references** themselves, making it superfluous to add that motivation to use servers may also be found in the knowledge of those of ordinary skill in the art of electronic commerce. It may be observed, first, that the court in *Ruiz* linked the three parts of the test by an **or** rather than an **and**; and,

secondly, that neither *Ruiz* nor any other precedent of which Examiner is aware contains any requirement that a statement of motivation be found in all of the prior art references combined to make a rejection under §103(a); it is fully sufficient that a statement of motivation be found in one such reference.

With regard to Appellant's final paragraph under Issue 1, Examiner observes that a statement of motivation in a prior art reference, while fully sufficient, is not always necessary; what is necessary is that some teaching, suggestion, or motivation to combine be found either in the references themselves or in the knowledge of those of ordinary skill in the art, or the nature of the problem to be solved (*Ruiz*). Appellant argues that with respect to the Examiner's Response to Challenges of Official Notice, Appellant acknowledges the numerous citations provided, but alleges that no evidence has been cited to support that the prior art would lead the skilled artisan to make the proposed modifications. Some of Examiner's takings of official notice have in any event been mooted by the amendments Appellant made after the first action rejection, and Appellant has not, with regard to any taking of official notice, specifically pointed out the supposed errors in Examiner's action, so Examiner will not defend each taking of official notice in detail, but as an example, Examiner will address his use of official notice in claim 20. In rejecting claim 20 ("The method of claim 19 wherein displaying the composite image on the output device displaying the composite image on a Web page"), Examiner observed that Fay, while not explicitly meeting the limitation, discloses use of the Internet (column 8, line 63, through column 9, line 4), and took official notice that it is well known to display images, and in particular, to display images of products

for sale, on Web pages. As a motivation, Examiner gave the obvious advantage of making the image conveniently available to the increasing multitude of customers with Web access. In response to Appellant's challenge, Examiner cited Montulli, U.S. Patent 5,774,670, column 12, lines 11-49, where the display of products for sale on a Web page is expressly taught.

Is the adequacy of this motivation seriously in question? Can Appellant sincerely maintain, and can the honorable members of the Board believe, that a person of ordinary skill in the art of electronic commerce, reading Fay at the time of Appellant's invention, would not have thought to display the composite image on a Web page, despite Fay's disclosure of displaying composite images, and Fay's disclosure of using the Internet, because Fay does not expressly disclose display on a Web page? To ask these questions is to answer them. The existence of Web pages, and their use in electronic commerce, would have been "in the knowledge of those of ordinary skill in the art" prior to the filing date, as would the publicity, hype, and public debate over the geometrically increasing popularity of the Web. Thus, the motivation of making images available to the increasing multitude of customers with Web access would likewise have been "in the knowledge of those of ordinary skill in the art."

Appellant's arguments regarding Issue 2 (claims 36-50) are almost word-for-word the same as the arguments regarding claims 1-2 and 4-24, and the responses which Examiner has set forth above can be considered to be repeated with full force, without any need to use more paper and ink.

Appellant's arguments regarding Issue 3 (claims 51-58) largely repeat the arguments made in Issues 1 and 2, and are held to be no more persuasive than they were before. There is, however, one notable variation, and Examiner recognizes the need to address this variation. Appellant argues that the storage medium of Fay fails to store a composite image, but rather stores a record of accessories. This is not news to Examiner, whose rejection of claim 51 reads, in relevant part:

Fay does not expressly disclose an information storage medium for saving data of the first composite image, the information storage medium being on or accessible to the server first computer, but Fay does disclose that the customer can order a pair of eyeglasses already tried on (column 6, lines 4-9 and 33-53), implying a storage medium storing a record of which eyeglasses (or other accessories) have been tried on.

This distinction is held not to render claim 51 and its dependents patentable, for it may be observed that claim 51 does not recite "an information storage medium for saving all data of the first composite image," but "an information storage medium for saving data **of** the first composite image" (emphasis added). Thus, claim 51 reads on a medium which saves some data from the first composite image, such as records of which eyeglass frames or other accessories were used in forming composite images of customers wearing accessories, which is what is inherent over column 6 of Fay. Furthermore, claim 51 recites no requirement that the "data of the first composite image" be saved for an extended period of time, so that, for example, a customer can later go back and view the composite image he viewed before, but merely "an

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information storage medium for saving data of the first composite image, the information storage medium being on or accessible to the server computer." Thus, the limitation is met by a buffer which temporarily stores at least some data of the first composite image in the course of the first composite image being transferred to the display device.

Hence, independent claim 51 is held to be unpatentable over Fay in view of the other prior art of records, just as independent claims 1, 13, 36 and 43 were, on the grounds set forth above.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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